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10/537,440	02/28/2006	Marc Husemann	101769-309-WCG	3424
27386	7590	12/18/2007	EXAMINER	
NORRIS, MC LAUGHLIN & MARCUS, P.A.			DESAI, ANISH P	
875 THIRD AVE			ART UNIT	PAPER NUMBER
18TH FLOOR			1794	
NEW YORK, NY 10022			MAIL DATE	DELIVERY MODE
			12/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,440	<b>Applicant(s)</b> HUSEMANN ET AL.
	<b>Examiner</b> ANISH DESAI	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 01 October 2007.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08e)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

#### DETAILED ACTION

1. Applicant's arguments in response to the Office action dated 06/28/07 have been fully considered.
2. Claims 1-15 are pending.
3. All of the previously made 35 USC Section 112-second paragraph rejections are withdrawn in view of the present amendment and response. However, upon further consideration a new 35 USC Section 112-second paragraph rejection is made.
4. The 35 USC Section 102(c) or 103(a) rejection based on Devaney et al. (US 2003/0049437A1) are withdrawn in view of the present amendment and response.
5. A new 35 USC Section 102(b) rejection is made based on Akhter (US 5,958,537).

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 3, 4, 7-9, 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 requires PSA tape having following multilayer construction of "pressure-sensitive adhesive layer/electrically conductive primer layer/carrier layer". The language of claim 7, specifically each layer separated by "/" symbol is confusing such that the structure of the PSA tape as claimed is difficult to ascertain. It is unclear as to whether Applicant is excluding any intervening layers between for example the PSA layer and the primer layer and

between the primer layer and the carrier layer. Additionally, claim 1 requires three layers (PSA layer, primer layer, and carrier layer) therefore are the layers of claim 7 additional layers? Similar reasoning applies to claims 8 and 9. For the purpose of the examination it is interpreted that there can be intervening layers present between the layers of claims 7-9 and the layers of claim 7 are not additional layers. As to claim 14, this claim recites “PETD” it is unclear as to what is PETD. For the purpose of the examination, PETD is interpreted as polyethylenedioxothiophene.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Akhter (US 5,958,537).

Akhter discloses a static dissipative label (antistatic pressure-sensitive adhesive tape) comprising a backing film (carrier layer), at least one pressure-sensitive adhesive layer, and a primer layer containing electrically conductive particles (electrically conductive materials) that is

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between the carrier layer and the pressure-sensitive adhesive layer (abstract, column 1 lines 4-11, column 1 line 65 to column 2 lines 1-18, and Figure). The electrically conductive particles of Akhter are metal particles (column 3 lines 29-30) and the electrically conductive materials of Akhter are homogeneously dispersed throughout the binder resin matrix of the primer layer (column 2 lines 4-12). Accordingly, Akhter anticipates claimed invention.

8. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Akhter (US 5,958,537).

The invention of Akhter as applied to claim 1 is previously disclosed in Section 9 above. Akhter is silent with regards to teaching the pressure-sensitive adhesive layer exhibits a shrinkback. However, it is reasonable to presume that the PSA layer of Akhter would exhibit a shrinkback as claimed. The support for said presumption is based on the fact that the PSA tapes of Akhter and that of Applicant comprise a carrier layer, a pressure-sensitive adhesive layer and at least one electrically conductive primer layer between the PSA layer and the primer layer. Further, Applicant and Akhter both disclose use of acrylic type adhesives (see PG PUB of this application and column 4 lines 45-46 of Akhter). Therefore, the PSAs of Applicant and Akhter are structurally and compositionally equivalent. Thus, the presently claimed feature of the PSA layer exhibiting a shrinkback would be present. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed feature of the PSA layer exhibiting a shrinkback would obviously have been present once the PSA of Akhter is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977).

9. Claims 4, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhter (US 5,958,537) alone.

Regarding claims 4 and 12, the primer layer of Akhter comprises conductive polymers such as polyaniline (column 2 lines 5-13 and column 4 lines 1-3), which reads on electrically conductive conjugated polymers. Alternatively, regarding claim 12, Akhter further discloses the primer layer comprising conductive particles comprising (i) inorganic oxides coated with a conductive material (column 2 lines 5-13 and column 3 lines 29-67), which reads on electrically doped material. Further, Akhter discloses that typically the conductive particles comprise at least about 30, preferably at least about 40 and more preferably at least about 50 weight percent of the combined weight of the binder resin and conductive particles (column 3 lines 44-47). Alternatively, with respect to the amount of electrically conductive materials as claimed, it is noted that Akhter discloses general condition of claims; specifically Akhter discloses an antistatic PSA sheet having a carrier layer, electrically conductive primer layer comprising conductive materials and a PSA layer. Akhter does not disclose the amount of electrically conductive materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the workable range of the amount of electrically conductive materials as claimed, since it has been held that when the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (see *In re Aller*, 105 USPQ 233).

10. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhter (US 5,958,537) in view of De Jonge et al. (US 6,284,837B1).

The invention of Akhter is previously disclosed. Akhter is silent with respect to teaching polymethacrylate PSA. However, De Jonge discloses PSA tapes and labels comprising polymethacrylate adhesives (see abstract and column 1 lines 35-40). It would have been obvious

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to one having ordinary skill in the art at the time the invention was made to use the polymethacrylate PSA as taught by De Jonge in the invention of Akhter, motivated by the desire to form the static dissipative label.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhter (US 5,958,537) in view of Schmeer et al. (US 4,536,441).

Akhter does not disclose the structure of the PSA tape as required by claims 8 and 9, however the invention of Schmeer is relied upon to teach that such structures of PSA are if not inherent, they are at least obvious in view of Schmeer's disclosure. Schmeer, specifically in abstract and at column 4 lines 39-50 contemplates a double sided adhesive tape having a primer coating on the surface of a backing layer (base layer). Thus, it would have been obvious to create a PSA tape as claimed in claims 8 and 9, motivated by the desire to enhance the strength of the tape.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhter (US 5,958,537) in view of Luhmann et al. (US 6,395,389B1).

Akhter is silent with respect to disclosing the PSA tape in the form of punched product. However, such punched tapes are known in the adhesive art as disclosed by Luhmann. The invention of Luhmann is directed to an adhesive tape strip (see abstract). According to Luhmann "Typical presentation forms [of the adhesive tape] include, punched adhesive tape strip sections covered on one side with a release laminate...forms." (column 4 lines 28-45). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tape in the form of a punched product because doing so would involve routine skill in the art.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhter (US 5,958,537) in view of Craig et al. (US 6,299,799B1).

Akhter is silent with respect to teaching electrically conductive conjugated polymers are 3,4-PEDT. However, Craig discloses creamer compositions that are capable of being cured to form antistatic, abrasion resistant creamers. Further the creamer compositions of Craig comprise electrically conductive organic polymers (abstract). The creamer compositions of Craig can be coated onto a substrate that can be a part of a pressure-sensitive adhesive tape (column 4 lines 1-9). Further, Craig discloses 3,4 polyethylenedioxythiophene (3,4 PEDT), polyaniline, and polypyrolyle as electrically conductive polymers (column 4 lines 33-37). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use 3,4 PETD in the invention of Akhter because selecting a known material based on its suitability for its intended use (purpose of providing static dissipation of charge) involves routine skill in the art.

#### *Response to Arguments*

14. Applicant's arguments received on 10/01/07 have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

APD

/Terrel Morris/  
Terrel Morris  
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